

(d) deflecting said tubular member into the branch wellbore and urging the same downhole until said flange is in sealed contact with a periphery of said window; and  
(e) removing the deflecting tool.

### REMARKS

This is a continuation reissue application of application serial no. 08/861,457. In that application, Applicant was granted a filing date of December 30, 1991, by way of a Decision on Applicant's Petition for the original date, the Decision dated October 8, 1999. By the filing of this continuation application and by way of preliminary amendment, Applicant has amended the specification, drawings, filing date, and original application papers to conform with the Decision and its parent application. Applicant has also canceled original claims 1-7 because they are currently pending in the parent reissue application.

In addition, in this continuation reissue application, Applicant is presenting and pursuing claims 8-14 that are either copied from or correspond to claims in U.S. Patent No. 5,787,987.<sup>1</sup> In the parent reissue application, Applicant had presented similar claims and formally filed a request for interference with the '987 patent. In an Office Action of April 18, 2000, the Examiner rejected the claims in the parent application that were copied from or corresponded to claims in the '987 patent and therefore declined to declare an interference at that time. Some of the then pending reissue application claims were rejected under 35 U.S.C. § 112, while others were rejected as unpatentable over the prior art.

To simplify the issues and move prosecution forward more promptly, Applicant through this continuation reissue application is presenting claims, along with remarks in favor of the

<sup>1</sup> Accordingly, the status of all patent claims and claims added to this application is that original patent claims 1-7 have been canceled and claims 8-14 have been added to this reissue application and are pending.

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claims. Once the Examiner concludes that the pending claims are supported by the specification and allowable over the prior art, Applicant will submit a formal request for interference. In that regard, Applicant respectfully requests that the Examiner notify Applicant's undersigned representative when the claims have been found to be allowable and in condition for a declaration of an interference, preferably through a telephone or a personal interview. As Applicant has previously advised the Patent Office, Applicant has a clear priority of invention over the '987 patent. In that regard, Applicant's filing date is December 30, 1991, while the filing date of the '987 patent is September 4, 1996.

In the parent reissue application, Applicant had sought an interference with the '987 patent based on then pending application claims 175-177, 198-204, and 210-212. As explained below, Applicant is no longer pursuing certain of those claims, has amended some of those claims, and respectfully traverses the rejection of other of those claims. Applicant respectfully submits that all of the claims now pending are in condition for allowance, subject to an interference with the '987 patent.

In the Office Action of April 18, 2000, in the parent reissue application, the Examiner rejected claims 175-177 and 210 as unpatentable over one or both of U.S. Patent Nos. 702,006 to Huffman and 2,270,476 to D'Audiffret et al. Applicant notes that claims 175-177 of the parent application were literal copies of claims 21-23 of the '987 patent and that claim 210 closely corresponded to independent claim 21 of the '987 patent. Thus, if the Examiner's rejection is correct, then claims 21-23 of the '987 patent are invalid.

Applicant is not now presenting claims that copy or closely correspond to claims 21-23 of the '987 patent. Applicant, however, reserves the right to consider further the validity and patentability of claims 21-23 of the '987 patent. Applicant also reserves the right to pursue

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claims that copy or correspond to claims 21-23 and again request that an interference be declared for those claims.

Claims 8-14 correspond generally to claims 198-204 previously presented in Applicant's parent reissue application. Specifically, claims 8 and 9 correspond to parent application claims 198 and 199, respectively. Claim 10 corresponds to prior application claim 202. Claim 11 corresponds to parent application claim 200. Claim 12 corresponds to parent application claim 203. Claim 13 corresponds to parent application claim 201. And claim 14 corresponds to parent application claim 204.

Claims 8-14 also correspond to claims 4-7, 20, and 27 of the '987 patent. Specifically, claims 8 and 11 correspond to '987 patent claim 4, but claim 11 is in method format. Claim 9 corresponds to '987 patent claim 5, and claim 13 corresponds to '987 patent claims 5-7 in method format. Claims 10 and 12 correspond to '987 patent claim 20, but claim 12 is in method format. And, claim 14 corresponds to '987 patent claim 27. While these claims are not identical to the corresponding claims of the '987 patent, Applicant submits that the respective claims are not patentably distinct.

In the Office Action of April 18, 2000, the Examiner did not reject any of parent application claims 198-204 as being unpatentable over the prior art. Thus, if the claims to this subject matter are found to overcome any § 112 issues, this case should be in condition for a declaration of interference.

In the Office Action of April 18, 2000, claims 198-204 were rejected under 35 U.S.C. § 251, based on the Examiner's view that the claims presented new matter added to the patent for which reissue is sought. Applicant does not agree with the rejection, as explained below.

Applicant is submitting new claims 8-14, which as discussed above correspond to claims 198-

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204. In certain instances, the pending claims do not include the identical language found in claims 198-204.

With respect to claims 198-203, the Examiner expressed the view that there is no embodiment in the original disclosure which has all of the limitations of these claims. The Examiner asserted that embodiments shown in Figures 4 and 10 meet the limitation of "said pipe being maintained substantially within said housing during run in" but does not have a first window having a periphery and second bore extending from the first borehole coextensive with the first window.

New independent claims 8, 9, 11, and 13, define that the window of the housing is placed at a position where the second borehole is to be formed. As shown in Figures 4 and 10 and described in the specification, Applicant discloses a lateral seal and control system having a first borehole and a housing having a window aligned with a position where the second borehole is to be formed, as claimed in claims 8, 9, 11, and 13. *See e.g.*, 8:49-58; 9:13-16; 16: 11-23; 45-49. Applicant further discloses a production pipe having a flange dimensioned larger than the premachined window, wherein the pipe is maintained within the housing during run in and is movable from the run in position to a deployed position wherein the flange is mated against the periphery of said premachined window, as claimed in claims 8, 9, 11, and 13. *See, e.g.*, 8:54-67; 9:1-3; 8-16. In addition, Applicant discloses energizing the flange against the periphery of the window, as further claimed in claim 9. *See, e.g.* 8:57-60; 9:8-9. Applicant, therefore, respectfully submits that claims 8, 9, 11, and 13 are fully supported by the reissue application under 35 U.S.C. § 251.

The Examiner did not provide any separate bases for the rejection of claims dependant from claims 198-201. Indeed, Applicant discloses an elastomeric sealing element on the flange

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as claimed in corresponding claims 10 and 12. *See, e.g.*, 9:2-3; 16:17-23. Accordingly, Applicant submits that claims 10 and 12, which depend from claims 9 and 11, respectively, are supported by Applicant's disclosure.

With respect to parent application claim 204, the Examiner asserted that Applicant's original disclosure does not support steps "c" and "e," asserting that the deflecting tool is not removed as required by step "c" and that the liner is not "kicked" in the branch wellbore as claimed in step "e." Applicant does not agree with the Examiner's view. Nevertheless, in order to facilitate prosecution of this application, new claim 14 recites the step of removing the deflector after the tubular member has been deflected into branch wellbore. Moreover, while Applicant does not agree that its deflecting tool is not "kicked" into the branch borehole as that term is used in the '987 patent, claim 14 now more broadly claims that the liner is "deflected" into the branch borehole. Applicant's disclosure clearly supports this broader terminology.

Applicant's disclosure, therefore, fully supports claim 14. For example, Applicant discloses drilling a wellbore and drilling a window and a branch wellbore by placing a deflecting tool in the wellbore and running a drill string from the wellbore. *See, e.g.*, 7:33-36, 49-58; 8:49-65; 9:13-21; 16:17-23, 28-31. Applicant also discloses running tubular member having a flange into the wellbore and deflecting the tubular member into the branch wellbore. *See, e.g.*, 7:64-67; 8:1-5, 66-67; 9:1-3; 16:28-31. The tubular member is urged downhole until the flange is in sealed contact with the periphery of the window. *See, e.g.*, 8:1-1-5, 15-20 57-60; 9:8-10; 16:40-41. Applicant further discloses removing the deflecting tool. *See, e.g.*, 8:21-28; 9:13-15; 16:41-44. For these reasons, Applicant respectfully submits that claim 14 is supported by the reissue application under 35 U.S.C. § 251. Applicant further notes that cases 4 and 4a, *see* Figs. 4 and 10, also provide support for the invention of claim 14.

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In the April 18, 2000, Office Action, claims 198-203 (and other claims) were rejected under 35 U.S.C. § 112, first paragraph "as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most clearly connected, to make and/or use the invention." According to the Examiner, these claims are either directly or indirectly related to the telescopic liner stub shown in Figs. 4 and 10. In that Office Action, the Examiner expressed the view that the liner stubs shown in the drawings cannot operate as disclosed in the specification or claimed. As result, the Examiner asserted that these claims are not enabled by the specification.

Applicant respectfully traversed the Examiner's argument of non-enablement in the parent application, and the Examiner withdrew that rejection. Applicant respectfully submits that prior claims 198-203, and new claims 8-13, are fully enabled by the original disclosure for the reasons argued and accepted by the Examiner in the parent application.

Applicant is also presenting proposed amendments to Figs. 4 and 10. These proposed amendments were discussed during an interview with the Examiner in the parent application and were accepted by the Examiner in that case. Applicant is formally submitting the proposed drawing changes in the accompanying Request for Approval of Drawing Changes. These drawings are the same as the drawings considered and accepted by the Examiner in the parent application. Applicant submits that these proposed drawings fully comply with the Office's Rules and the MPEP.

For the reasons stated above, Applicant requests an indication that the claimed subject matter is supported by Applicant's specification and is directed to patentable subject matter. Applicant is prepared to promptly file a formal request for interference, upon an indication of allowable subject matter. Again, Applicant requests that the Examiner notify the undersigned by

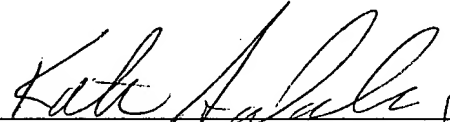
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phone as soon as the examination of the claims is complete so that Applicant can file a request for interference and otherwise assist the Examiner in his consideration of that request.

Respectfully submitted,



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